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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,654	04/27/2001	Haruhiko Kinoshita	048369/0123	7693

22428 7590 04/06/2007  
FOLEY AND LARDNER LLP  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
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3693

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/842,654

**Applicant(s)**

KINOSHITA, HARUHIKO

**Examiner**

Jason M. Borlinghaus

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/28/06 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 22 – 30** are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Taken as a whole, the application recites such long recitations and unimportant details that the scope of the claimed invention is rendered indefinite thereby and by virtue of the unreasonable and unnecessary length of the claims presented, would tend to obfuscate, confuse, and becloud the claimed invention. Claims are rejected as prolix when they contain such long recitations that the metes and bounds of the claimed subject matter cannot be determined. See *MPEP* § 2173.05(m).

To be complete, a response should include rewritten and reorganized claims so as to particularly point out and distinctly claim the subject matter which Applicant

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regards as the invention, or Applicant must present appropriate arguments as to why the above rejection is in error.

Examiner will attempt to apply art to the claims in their current condition to the extent possible.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 22 – 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Zucknovich (US Patent 5,940,843) in view of Disclosed Prior Art (specification, pp. 1 – 4) and Official Notice.

Zucknovich discloses a corporate rating (information/opinion) system:

- wherein a communication terminal of a corporate rating business entity (research provider/contributor) engaging in a business of performing

corporate ratings (research/review) having said communication terminal (networked workstation terminals), a communication terminal of one or a plurality of enterprises (viewers) each having said communication terminal (viewer workstation) and each desiring a corporate rating (research/review), and having a relationship with a server (repository server) and said corporate rating business entity (research provider/contributor), said each one of said target enterprises (viewers), and are mutually electrically connected via an appropriate communication circuit (network) (see abstract; col. 1, line 22 – col. 2, line 60); and

- wherein said server (repository server) comprises storage means for storing business information (research) indicating general business activities of each one of said target enterprises (companies), separately, into one of a specific areas of said storage means provided in said server and wherein access to said access to such records are controlled based upon the relationships between parties. (see col. 1 – col. 4).

Disclosed Prior Art discloses a corporate rating system wherein:

- a corporate rating business entity in a business of performing corporate ratings, one or a plurality of enterprises (specific enterprise) having a relationship with said corporate rating business entity and desiring a corporate rating of itself. (see specification, p. 1, lines 15 – 17); and
- an information source are mutually electrically connected via a communication circuit (network). (see specification, p. 1, lines 17 – 22);

- wherein business information indicating general business activities, including at least financial (financial report), accounting (accounting report) and tax information (tax report) for each target enterprise is stored at said information source for each said target enterprise is stored at said information source for each target enterprise. (see specification, p. 1, lines 21 – 27);
- said system comprising a function whereby said corporate rating business entity having an proprietary corporate rating software obtains required information with regard to said target enterprise desiring a corporate rating from said information source and performs a corporate rating for said target enterprise using said proprietary corporate rating software. (see specification, p. 1, line 27 – p. 2, line 2);
- said operation of obtaining business information indicating general business activities of each enterprise (via computer network) and said operation of performing a corporate rating with respect to each said enterprise at said corporate rating business entity are performed by a computer (via proprietary corporate rating method software). (see specification, p. 1, line 15 – p. 2, line 2);
- use of a communication circuit (computer network/telephone) to obtain an accounting report. (see specification, p. 1, lines 15 – 24);
- production of accounting report by accounting firm (see specification, p. 2, line 23 – p. 3, line 2);

- said accounting firm views or downloads business information (contained within ledger) indicating general business activities, that include at least one of financial, accounting, and tax information of each target enterprise. (see specification, p. 3, lines 14 – 27);
- based on said business information (ledger), evaluates details of closing account of said enterprise (closing the books). (see specification, p. 3, lines 14 – 27);
- issues a document certifying the accuracy and appropriateness of details of closing account of said enterprise (see specification, p. 3, line 28 – p. 4, line 2);
- said corporate rating business entity refers to the signature (accounting firm signature on financial accounting report) and executes a corporate rating evaluation of a prescribed enterprise in accordance with the signature. (see specification, p. 4, lines 3 – 17);
- wherein said business information (disclosure documents) of each target enterprise (specific enterprise) is provided to said corporate rating entity by each said target enterprise (specific enterprise) via said communication circuit (computer network). (see p. 1, lines 15 – 24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Zuchnovich by incorporating a corporate rating system, as disclosed by Disclosed Prior Art, as the automated and online exchange of

corporate information enabled by Zuchnovich would allow for automation of the manual corporate rating system, as disclosed by Disclosed Prior Art.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have automated the method, since it has been held that broadly providing a mechanical or automatic means to replace manual activity that accomplishes the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Examiner takes **Official Notice** that the use of an application service provider for management and use of applications, and processing of information in a network environment is old and well known in the arts of information technology.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Zucknovich and Disclosed Prior Art by incorporating an application service provider, as is old and well known, as such use of such technology is standard and conventional in network environments.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

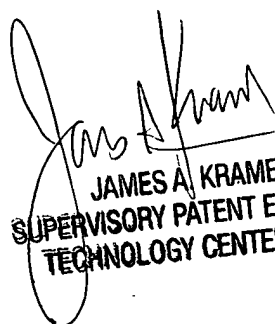
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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 4/2/07  
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